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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/876,276 06/16/97 SHORT

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EXAMINER

TUNG, P

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

07/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

08/876,276

Applicant(s)

Short et al.

Examiner

Peter Tung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 16, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 19 20) ☐ Other:

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DETAILED ACTION

1. Claims 19-45 are pending.
2. Due to new grounds of rejection based upon the Continuation in Part of the instant application, the finality of the previous Office action is hereby withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of screening DNA to identify lipases, esterases, glycosidases, proteases, and monooxygenases through the use of bioactive fluorescent substrates does not reasonably provide enablement for the use of said screening method to identify glycosyl transferases, phosphatases, kinases, diarylpropane peroxidases, epoxide hydrolases, nitrile hydratases, nitrilases, transaminases, amidases and acylases. This rejection is explained in the previous Office action.
5. Applicants argue that there are numerous publications demonstrating enzymes and fluorescent substrates as well as methods of making fluorescent substrates known in the art, demonstrating the skill in the art at the time the application was filed. Applicants argue that those of skill in the art can practice the invention using guidelines provided by the specification without

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undue experimentation and that the specification discloses use of substrates that are fluorescent in the presence of glycosyl transferases, phosphatases, kinases, diarylpropane peroxidases, epoxide hydrolases, nitrile hydratases, nitrilases, transaminases, amidases and acylases. The technique for using such substrates in practice of the invention methods does not differ substantially from the examples disclosed. Applicants further argue that substrates that fluoresce in the presence of glycosyl transferases, phosphatases, kinases, diarylpropane peroxidases, epoxide hydrolases, nitrile hydratases, nitrilases, transaminases, amidases and acylases were well known in the art at the filing date of the instant application and identified by the attached references.

6. Applicant's arguments filed 4/19/01 have been fully considered but they are not persuasive. While there may be numerous publications demonstrating enzymes, fluorescent substrates and methods of making fluorescent substrates, Applicants have not provided any references identifying such teachings in the art for glycosyl transferases, phosphatases, kinases, diarylpropane peroxidases, epoxide hydrolases, nitrile hydratases, nitrilases, transaminases, amidases and acylases. The instant specification does not provide any information on the specific fluorescent substrates.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 19 and 25 are rejected under the judicially created doctrine of double patenting over claims 22 and 23 of U. S. Patent No. 6,174,673 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claims are directed to a method of identifying bioactivity by high throughput screening comprising the same steps.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9. Claims 19-24 and 26-45 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-11, 15, 16, 18, 19, 21 and 21 of U.S. Patent No. 6,174,673. Although the conflicting claims are not identical, they are not patentably

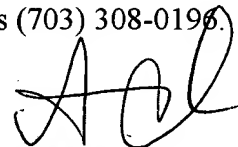
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distinct from each other because the instant claims are drawn to a method of identifying bioactivity by high throughput screening comprising the same steps.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Tung, Ph.D. whose telephone number is (703) 308-9436. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, Ph.D., can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



PONNATHAPU ACHUTAMURTHY
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